

REMARKS

The Office Action has been carefully reviewed. Claims 1-31 are pending. Claims 1, 12, 14, and 31 have been amended. Support for the amendments is found throughout the specification, such as, for example, at page 6, line 15 - page 7, line 6 and page 21, lines 4-20. No new matter has been added. Entry of the amendments to the claims is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.¹

I. Rejections Under 35 U.S.C. § 102

Claims 1-31 have been rejected under 35 U.S.C. § 102 as allegedly being anticipated by U.S. Patent No. 7,310,617 to Cunningham (“Cunningham”). *See* Office Action, pages 3-10. Applicant hereby respectfully traverses this rejection.

Regarding claim 1, Applicant respectfully disagree with the Examiner’s assertion that Claims 1-13 have the same elements as method claims 14-31. *See* Office Action, page 9. Specifically, the Office Action states “[r]egarding claims 1-13, these claims include the necessary processors and components for implementing the method claims 14-31 and have the same elements and limitations. Hence they are rejected under the same rationale provided in claims 14-31. *See id.* The Office Action fails to address elements of claims 1-13 which are different from claims 14-31. For example, claim 1 recites “wherein the pre-qualification data relates to at least one financial instrument associated with the financial institution that the

¹ As Applicant’s remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicant’s silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes, Examiner interpretations of claims, Examiner interpretations of the specification) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

consumer is qualified to be offered based on information stored in a pre-qualified consumer database that is accessed by the third party upon receipt of the consumer information from the system.” Thus the rejection of claims 1-13 improperly ignores elements of the claims and must be withdrawn.

As stated in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Regarding claim 14, the Examiner asserts that Cunningham discloses a method for offering financial instruments to pre-qualified consumers, comprising “receiving information related to personal identification information associated with a consumer ... the consumer personal identification information being **received prior to a consumer contact**.” Applicant respectfully disagrees.

Cunningham states:

The present invention-which may be accessed via the World Wide Web-**prompts a user for pertinent information**. Additional credit history data may be obtained using the personal and financial information provided by the user. A user may then be assigned a financial rating or grade/score based on the personal, financial, and credit history data provided to the system of the present invention. The financial risk rating may be used to locate financial card offers.

Cunningham; summary of the invention, col. 2, lines 20-27 (emphasis added). Cunningham further states that the “**process begins when a user (applicant) completes an application** 40 by providing personal and financial information.” Cunningham; col. 4, lines 14-16 (emphasis added). Cunningham is directed towards a user accessing a web site, providing information, and then being presented with credit card offers. *See* abstract. In contrast, claim 14 recites “receiving information related to personal identification information associated with a consumer

... the **consumer personal identification information being received prior to a consumer contact.**” The Examiner cites Cunningham, col. 5, lines 12-38 and Figure 3 in support of the assertion that Cunningham discloses these elements. In contrast, the cited portions of Cunningham are directed towards receiving “participating financial institution data,” not personal identification information associated with a consumer. *See* Cunningham; col. 5, lines 18-21 (“In the first step 60, participating financial institutions provide contact and other information that may be needed to complete a transaction using the present invention (participating financial institution data.)”) Participating financial institution data such as financial institution contact information and financial card term data fails to disclose “receiving information related to personal identification information associated with a consumer ... the consumer personal identification information being **received prior to a consumer contact.**”

As the Federal Circuit recently stated:

the law of anticipation ... requires the specific description as well as enablement of the subject matter at issue. To anticipate, the reference ‘must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’ *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)); *see also, e.g., In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (‘[The] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.’ (emphasis in original))

See Sanofi -Synthelabo v. Apotex, Inc 89 USPQ2d 1370, 1375 (Fed. Cir. Dec. 12, 2008).

Accordingly, Applicant respectfully submits that Cunningham fails to disclose “receiving information related to personal identification information associated with a consumer ... the consumer personal identification information being received prior to a consumer contact.”

Claim 14 of the present application further recites:

receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database, wherein **the suppression database comprises a plurality of second consumer files**, each of the second consumer files linked to a unique consumer identifier, wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the **second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file**.

(Emphasis added). Applicant respectfully submits that Cunningham fails to disclose “receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database,” as recited by claim 14. The Examiner asserts that this limitation is met by col. 3, lines 32-49 of Cunningham. Applicant respectfully disagrees. The Examiner’s citations alleged to disclose two separate element of claim 14 refer to a single aspect of Cunningham, use of a credit bureau data. Specifically, the Examiner asserts that col. 4, lines 22-34 and Figure 2 of Cunningham disclose “inquiring a third party ...whether the consumer has been pre-qualified for a financial instrument ..wherein **the pre-qualification is based at least in part on a first consumer file.**” The cited portion of Cunningham, at best refers to grading an applicant based on credit bureau information. The Examiner further asserts that the “suppression database [which] comprises a plurality of second consumer files” is disclosed by col. 3, lines 32-49 of Cunningham. This cited portion of Cunningham is again directed towards the use of credit bureau data. Applicant respectfully submits that Cunningham fails to disclose a “suppression database [which] comprises a plurality of second consumer files.”

Regarding claims 1, 12, and 31, although these claims are of different scope than claim 14, these claims recite subject matter related to claim 14. Accordingly, Applicant respectfully

submits that claims 1, 12, and 31 should be allowable over Cunningham for analogous reasons as set forth above with respect to claim 14.

Regarding dependent claims 2-11, 13, and 15-30, these claims are dependent upon independent claims 1, 12, and 14, respectively. Thus, since independent claims 1, 12, and 14 should be allowable as discussed above, dependent claims 2-11, 13, and 15-30 should also be allowable at least by virtue of their dependency on independent claim 1, 12, and 14, respectively. Moreover, these claims recite additional features which are not taught or even suggested, by the applied references taken either alone or in combination.

In view of the foregoing, Applicant respectfully requests that the aforementioned anticipation rejection of claims 1-31 be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.


Respectfully submitted,

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